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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,264	02/06/2004	Fumihiro Yamaguchi	248606US0	4447

22850 7590 01/24/2008  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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JOHNSON, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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01/24/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/772,264	YAMAGUCHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jenna-Leigh Johnson	1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. The response filed on October 30, 2007 has been entered. Claims 1 - 10 are pending. Claim 8 is withdrawn from consideration as being drawn to a nonelected invention.

#### *Claim Rejections - 35 USC § 112*

2. Claims 1 - 7, 9, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure fails to provide proper support for the limitation that microfiber B is both less than or equal to microfiber A and greater than  $1/1.76$  of the size of microfiber A. As set forth previously the disclosure does teach that Microfiber B is less than or equal to Microfiber A.

However, newly added limitations must be supported in the specification by express, implicit, or inherent disclosure that would be obvious to and appreciated by one having ordinary skill of the art upon examining the disclosure. Hence, while the applicant does not need literal support for the claimed range of greater than  $1/1.76$ , this range must be understood by one having ordinary skill in the art upon review of the disclosure. If the disclosure does not sufficiently suggest the range as claimed, then the limitation is considered to be new matter because it was not clearly taught by the applicant in the original disclosure.

In the present case, the applicant provided an example made with a first fiber having a fineness of 0.016 dtex and a second fiber with a fineness of 0.0091 dtex. The ratio of these two fibers is  $1/1.76$ . However, the applicant never acknowledges the ratio of these fibers or suggests that fibers systems with a similar ratio would be desired in the present invention. And while the two fibers have the claimed ratio, the example in no way provides support for any other combination of fibers with a fiber fineness ratio such as 0.032 and 0.0182. The ratio encompasses not only the two fibers provided in the example, but also a wide range of fiber combinations which are not taught or suggested by the two specific fiber sizes. The ratio represents a genus of fiber combinations which includes the two fiber sizes disclosed by the example as a

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specific species within the genus. And just as a teaching to a species is not considered to suggest or teach the entire genus, the teaching of the two specific fibers sizes in the example cannot be used to teach the entire combination of two fiber systems represented by the ratio of 1/1.76. Nor, would one having ordinary skill in the art interpret the example to teach all fiber combinations having the claimed ratio instead of the two fiber sizes disclosed. Thus, this example and the teachings of two specific fibers does not provide support for any other fiber systems with the claimed ratio and hence, would not provide support for the entire ratio as claimed by the applicant. There is no teaching that the ratio of the two sizes and not the absolute sizes of the fibers themselves should be used by one of ordinary skill in the art to choose the sizes of the fibers. Thus, the example provides support only for materials with a first fiber having a fineness of 0.016 dtex and a second fiber with a fineness of 0.0091 dtex.

Further, it is noted that the claimed range is not just 1/1.76, but 1/1.76 *or more*. There is no teaching or suggestion within the specification that the ratio of the fibers in the example is a desired minimum ratio of the two fiber sizes. The example provides no teaching with respect to fiber combinations having ratios lower than this ratio or fiber combinations having ratios higher than this ratio. It is completely silent to any other specific combination of fibers. Thus, there is no support for the *or more* portion of the limitation in combination to the ratio of the fibers. The disclosure does not provide any suggestion to those with ordinary skill in the art that the ratio of the fibers in the example is desired and even less suggestion that the fiber combinations having a fiber ratio greater than 1/1.76 are taught by the example.

The applicant argues that the disclosure that the fineness of the fibers satisfy the equation  $0.1 \times A < B < A$  suggests that the ratio of the fibers are critical to invention and that the equation  $1/1.76 \times A > B > A$  is just further limiting the range taught by the equation. First, the equation does not compare ratios of the two fiber sizes, but just provides a limit on the absolute fiber size of Microfiber B. Second the inequality is an equation, calculated based on the size of the fibers and not specific range fiber sizes. The applicant's argument is based on the substitution of one constant, 0.1, for another constant, 1/1.76 in the cited equation. It is not obvious to those with ordinary skill in the art that the equation can be modified by substituting the

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original constants for other values. While the equation may allow one of ordinary skill in the art to choose a wide range of fibers sizes for Microfiber B, there is no suggestion or teaching in the specification that would lead one of ordinary skill in the art to substitute different constants for the constants already present in the equation. Further, there is no suggestion that the equation can be modified using the ratio of the fibers in the example as the lower end constant. In fact, the disclosure in no way connects the constants of the equation to the ratio of the fibers used in the example. Thus, one of ordinary skill in the art would not modify the equation to use the ratio of the fibers as the lower end constant as suggested by the applicant without a more specific teaching provided in the disclosure. It would not be implicit to the disclosure or understood by one having ordinary skill in the art. And further, there is not a sufficient amount of teaching that leads one of ordinary skill in the art to use the ratio of the fibers in the example, not only as one of the constants in the equation, but as the constant limiting the minimum fiber size of Microfiber B. Without further teachings one of ordinary skill in the art would not modify the equation to read  $1/1.76 \times A > B > A$ . Thus, the claimed limitation is not expressly or implicitly taught by the specification. Therefore, the limitation is considered to be new matter.

Further, the applicant argues that *In re Wertheim* provides support that the fiber ratio of the example can be used as an end point in the claimed size of Microfiber B. However, *In re Wertheim* is not considered to be sufficiently similar to the present situation since the applicant is not simply choosing a value from within a specific range. Thus, the rejection is maintained.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and

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any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Johnson whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlj  
January 16, 2008

/Jenna-Leigh Johnson/  
Primary Examiner  
Art Unit 1794